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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,080	10/31/2003	Barbara Isenberg	03727-P0048C	1847

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EXAMINER

MILLER, BENA B

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,080

Applicant(s)

ISENBERG, BARBARA

Examiner

Bena Miller

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 2, the examiner is not sure if applicant is claiming the combination of the toy and the accessory or the subcombination of the toy only. This in turn, is because while line 1 of the claim appears to indicate that applicant's intention is to claim only the toy. In this Office Action, the examiner presumes that the applicant's intention is to prosecute the subcombination of the toy, in order that the claims are given their broadest reasonable interpretation. Accordingly, all additional limitations that are dependent on the accessory are not considered further structurally limiting with respect to the claimed device.

Regarding claim 7, it is not clear how the at least one portion is modified to removably receive the accessories. In other words, it is not clear what structure is encompassed by the phrase "modified to removably receive said accessories".

Regarding claim 14, there is lack of antecedent basis for the "said foot".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hay et al.

Regarding claims 1 and 8, Hay teaches in the figures a toy comprising a figure having a hole disposed in a portion therein (the hole in the support 9 or 10 of the piece 3) and at least one ferrous portion (8; it should be noted that the examiner takes the position that the magnet 8 of Hay et al meets the limitation), a manipulator having a magnet (13) and a stage (2). It should be noted that a recitation with respect to the manner in which a claimed apparatus intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations.

Regarding claim 12, Hay further teaches the at least one ferrous portion within at least one foot of the figure (fig.6).

Regarding claim 13, Hay further teaches the toy further at least one accessory (the attire worn by piece 3, ice-hockey player; note: fig. 3 and col. 3, par. 2).

Regarding claim 15, Hay further teaches a multiplicity of accessories (15, 16).

Regarding claim 16, Hay further teaches the figure having a hole in a portion thereof (the hole in the support 9 or 10 of the piece 3).

Claims 8 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldfarb.

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Goldfarb teaches in the figures a toy comprising a figure (40) having at least one ferrous portion (44; it should be noted the examiner takes the position that the magnets 44 of Goldfarb meets the limitation), a manipulator (46) having a magnet (56), and a stage (12). It should be noted that a recitation with respect to the manner in which a claimed apparatus intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations.

Regarding claim 18, Goldfarb further teaches the stage having an animation surface on one side (col. 2, lines 50-52) and a bottom surface (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parson in view of Woolington.

Parson teaches in the figures most of the elements of the claimed invention except for a plush figure. Woolington teaches a plush doll that is capable of talking and moving its head in to response to an external sound. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the figure of Parson plush as taught by Woolington for the purpose of providing a soft material toy to prevent possible injuries to a child when playing. It should be noted that a recitation with respect to the manner in which a claimed apparatus intended to be employed does not

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differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations.

Claims 2, 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unalp et al in view of Ware.

Regarding claims 2 and 5, Unalp teaches most of the elements of the claimed invention except for a plush teddy bear figure. Ware teaches in the figures a plush teddy bear figure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the figure of Unalp plush as taught by Ware for the purpose of providing a soft material toy to prevent possible injuries to a child when playing.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfarb in view of Kane.

Goldfarb teaches in the figures most of the elements of the claimed invention except for a bendable and poseable figure. Kane et al teaches in the figures a poseable toy figure that is formed of a wire armature (p. 6, par. 5 and 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a bendable and poseable as taught by Kane et al for the figure of Goldfarb for the purpose of articulating the figure in different positions.

Claims 10 and 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfarb in view of Woolington.

Goldfarb teaches in the figures most of the elements of the claimed invention except for a cat plush figure. Woolington teaches a plush doll that is capable of talking

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and moving its head in to response to an external sound. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the figure of Goldfarb plush as taught by Woolington for the purpose of providing a soft material toy to prevent possible injuries to a child when playing. Further, it would be considered a mere design choice to have the plush figure to be a cat.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hay.

Hay teaches in the figures most of the claimed elements except for the shoes being removably attached to each foot. It would have been obvious to one having ordinary skill in the art at the time the invention was made have the shoes removably attached to each foot, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Elicnman*, 168 USPQ 177, 179.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hay in view of Hastey.

Hay teaches in the figures most of the element of the claimed invention except for a storage box. Hastey teaches in the figures a box 200 used to package a doll. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a storage box as taught by Hastey for the toy of Hay for the purpose of packaging the toy.

Allowable Subject Matter

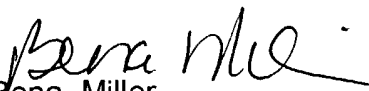
Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Knowles teaches a magnetic toy. Hooper teaches a magnetic assembly toy. Zailine teaches a rotary magnet toy. Lemelson teaches a modular toy. Crawford teaches a toy. Lindman teaches a magnetic game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Bena Miller
Examiner
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